



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Am

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,617	08/17/2000	David Platt	TIVO0043	6921

7590 05/18/2005
TiVo Inc.
2160 Gold Street
P.O. Box 2160
Alviso, CA 95002

EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
----------	--------------

2136

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/642,617

Applicant(s)

PLATT, DAVID

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Original application contained Claims 1 – 26. Applicant previously added Claims 27 and 28. Applicant previously amended Claims 1, 4 – 13 and 17 – 26. Therefore, presently pending claims are 1 – 28.

2. Applicant's submission filed on February 22, 2005 has been entered and made of record.

Response to Arguments

3. Applicant's arguments with respect to claims 1 – 28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 – 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 states “generating ...”, “transmitting ...” and “validating ...”. These limitations are considered non-statutory subject matter because they consist software code for generating a value (page 8 lines 14 – 29).
5. Dependent Claims 2 – 13 are rejected based on their dependency from Claim 1.
6. To expedite a complete examination of the application, the claims rejected under 35 U.S.C. 101 (non-statutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2136

7. Claims 1- 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Vicard (U.S. Patent Number 5,764,761).

8. Regarding Claim 1, Vicard teaches

generating a challenge value at said first party (Column 3 lines 8 – 20);
transmitting said challenge to said second party (Column 3 lines 8 – 20);
generating a response value using a lock value at said second party, wherein said lock value indicates a desired access mode (Column 3 lines 21 – 54);
transmitting said response value to said first party (Column 3 lines 40 – 55); and
validating said response value by said first party (Column 3 line 40 – Column 4 line 2).

9. Regarding Claim 14, Vicard teaches

means for generating a challenge value at said first party (Column 3 lines 8 – 20);
means for transmitting said challenge to said second party (Column 3 lines 8 – 20);
means for generating a response value using a lock value at said second party; wherein said lock value indicates a desired access mode (Column 3 lines 21 – 54);
means for transmitting said response value to said first party (Column 3 lines 40 – 55); and

means for validating said response value by said first party (Column 3 line 40 – Column 4 line 2).

10. Claims 2 and 15 are rejected as applied above in rejecting claims 1 and 14. Furthermore, Vicard teaches and describes said first party is a disk drive and said second party is a host computer (admitted prior art, instant application Fig. 1; Column 3 lines 1 – 7 and Column 6 lines 5 – 57).

11. Claims 3 and 16 are rejected as applied above in rejecting claims 1 and 14. Furthermore, Vicard teaches and describes said disk drive is locked when not accessed (admitted prior art, instant application Fig. 1 and Column 2 lines 57 – 65).

12. Claims 4 and 17 are rejected as applied above in rejecting claims 1 and 14. Furthermore, Vicard teaches and describes using 512 bits for said challenge value and using 512 bits for said lock value (Column 4 lines 25 – 51).

13. Claims 5 and 18 are rejected as applied above in rejecting claims 1 and 14. Furthermore, Vicard teaches and describes randomly generating said challenge value (admitted prior art, instant application Fig. 1 and Column 3 lines 1 – 36).

Art Unit: 2136

14. Claims 6 and 19 are rejected as applied above in rejecting claims 1 and 14.

Furthermore, Vicard teaches and describes using a disk drive controller to generate said challenge value (admitted prior art, instant application Fig. 1; Column 3 lines 1 – 7 and Column 6 lines 5 – 57).

15. Claims 7 and 20 are rejected as applied above in rejecting claims 1 and 14.

Furthermore, Vicard teaches and describes using an exclusive OR to combine said challenge value and lock value (Column 3 lines 21 – 36).

16. Claims 8 and 21 are rejected as applied above in rejecting claims 1 and 14.

Furthermore, Vicard teaches and describes using 160 bits for said response value (Column 3 lines 21 – 36).

17. Claims 9 and 22 are rejected as applied above in rejecting claims 1 and 14.

Furthermore, Vicard teaches and describes said step of generating a said response value further includes the step of using a cryptography circuit to generate said response value (admitted prior art, instant application Page 3 lines 24 – 30 and Column 2 line 57 – Column 3 line 20).

18. Claims 28 and 27 are rejected as applied above in rejecting claims 1 and 14.

Furthermore, Vicard teaches and describes said step of validating said response value further includes unlocking the disk drive in accordance with the desired access mode

Art Unit: 2136

indicated by the lock value if the response value is valid (admitted prior art, instant application Fig. 1 and Column 5 line 29 – Column 6 line 31).

19. Claims 10 and 23 are rejected as applied above in rejecting claims 9 and 22.

Furthermore, Vicard teaches and describes the step of using an algorithm to generate said response value (Column 3 lines 21 – 36).

20. Claims 11 and 24 are rejected as applied above in rejecting claims 6 and 14.

Furthermore, Vicard teaches and describes a secure hash algorithm to generate said response value (Column 3 lines 40 – 54).

21. Claims 12 and 25 are rejected as applied above in rejecting claims 11 and 19.

Furthermore, Vicard teaches and describes

said disk drive controller receives the challenge value and the lock value
(Column 3 lines 1 – 7);

computing a duplicate response value on said disk drive controller by performing
a duplicate secure hash algorithm (Column 5 line 55 – Column 6 line 31); and

comparing said response value to said duplicate response value (Column 5 line
55 – Column 6 line 31).

22. Claims 13 and 26 are rejected as applied above in rejecting claims 12 and 15.

Furthermore, Vicard teaches and describes unlocking the disk drive in accordance with the desired access mode indicated by the lock value if the response and duplicate response value match (Column 5 line 55 – Column 6 line 31).

Conclusion

20. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific

Art Unit: 2136

disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on Tuesday – Thursday 8:00a.m. To 3:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy

May 13, 2005.


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100